

Remarks

Claim Rejections Under §103(a):

Paragraph 2 of the Action rejects claims 1-28 under 35 U.S.C. 103 (a) as being obvious over Cudahy (US Patent 6, 567,822). Applicant respectfully traverses this rejection for at least the reasons sated below.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” (See MPEP §706.02(j)).

In this instance, the Action fails to establish any of the three requirements required for a *prima facie* case of obviousness. First, the Action fails to establish a *prima facie* case of obviousness because Cudahy fails to disclose each and every element of the claims. Further, the Action fails to establish a *prima facie* case of obviousness because Cudahy fails to provide the proper motivation to modify the teachings of Cudahy in order to obtain the invention as claimed. Further, Cudahy does not include a suggestion that if one were to modify the teachings of Cudahy, one would be successful on obtaining the invention as claimed.

For example, with respect to claim 1 Cudahy fails to teach, suggest, or disclose building a profile for one of the users based on responses to a poll presented through a webpage as required

by claim 1. In fact, the Action admits that Cudahy fails to teach the above limitation of claim 1. The Action attempts to make up for the admitted deficiency of Cudahy to teach all the limitations of claim 1 by stating that Cudahy suggests building a user profile as required by claim 1, and cites several passages from the detailed description of Cudahy; however, Applicant has reviewed each of these passages as well as the entire detailed description of Cudahy and Applicant failed to find any reference to a user profile or any suggestion that a user profile could, or should be established. Accordingly, Applicant asserts that Cudahy fails to teach, suggest or disclose building a user profile for one of the users based on the information collected via polls.

Because Cudahy fails to teach all of the limitations of claim 1, the Action must show that Cudahy includes a suggestion to modify the teachings of Cudahy, based on information generally known to those of skill in the art, to obtain the invention as claimed, and that one of skill in the art would be successful in obtaining the inventions claimed by implementing any such suggested modifications. Accordingly, in order to properly demonstrate that Cudahy includes the proper motivation, the Action must show two things: 1) that one who is skilled in the art would know to use user profiles developed based on data obtained and response to polls issued over the internet, and 2) that Cudahy contains some motivation to modify its own teachings based on this known use of user profiles. In this instance, the Action fails to establish that either is true.

The Action attempts to bootstrap the first requirement by taking official notice that building such user profiles were well-known and expected in the art by one of ordinary skill at the time of the invention; however, as noted in the Background and the Summary of the present invention, prior art systems and approaches were deficient precisely because they failed to aggregate responses at a central location and, e.g., use the aggregated data to build user profiles. The establishment of user profile as taught in the present application was a direct response to the

failures of these prior art systems (See, e.g., the Summary). The Action provides no evidence that prior to the invention as disclosed in the present application that use of such user profiles in the manner taught in the present application, and claimed in claim 1, was known in the prior art.

Accordingly, the Action fails to meet this requirement needed to show that the element of claim 1 missing from Cudahy was generally known by those of skill in the art at the time the invention was made. As such, the Action fails to establish a *prima facie* case of obviousness, with respect to claim 1, because the Action admits that an element of claim 1 is not taught by Cudahy, and the Action fails to supply any evidence to suggest that the missing element was generally known in the prior art.

Moreover, even if use of user profiles was known, the rejection must fail because Cudahy includes no motivation to modify the teachings of Cudahy in order to use user profiles. In attempting to bootstrap this secondary requirement needed to show a proper motivation to modify the teachings of Cudahy, the Action states that Cudahy teaches receiving answers to questionnaires and storing them in a database so as to perform assessments. The Action then states that this teaching of Cudahy implies building a user profile. Applicant, respectfully disagrees, because an assessment is not the building of a user profile nor is a user profile needed in order to perform an assessment. Cudahy is clearly directed to systems and methods for aggregating information that can be used to assess various processes or projects (see the Summary). Cudahy does not teach, suggest, or disclose, in any way, the aggregation of data in order to establish user profiles nor does it even teach the aggregation of data in order to assess anything about the users of the system.

But even if Cudahy was concerned with the assessment of the users, nothing in Cudahy suggests that you would have to build a user profile before performing such an assessment. Such

a system could, if it were concerned with the assessment of users which it is not, simply receive the data and perform the assessment, and Cudahy suggest nothing to the contrary. In short, nothing in Cudahy teaches, suggests, or discloses that user profiles are needed to perform assessment, nor would one expect Cudahy to suggest that such was the case, since Cudahy is not concerned with the assessment of users. Rather, Cudahy is concerned with value chain assessment.

Thus, not only does the Action fail to establish a *prima facie* case of obviousness because it fails to show that Cudahy discloses all the limitations of claim 1, but also because it fails to establish that there was any motivation to modify the teachings of Cudahy to achieve the invention as claimed in claim 1. Further, the Action fails to even address whether or not one would be successful in achieving the invention as claimed in claim 1 if the teachings of Cudahy were to be modified.

Accordingly, Applicant respectfully requests withdrawal of the rejection as to claim 1 because the Action fails to establish a *prima facie* case of obviousness based on Cudahy. Further, because claims 2-14 ultimately depend from claim 1 which is itself allowable over the art of record, Applicant respectfully requests withdrawal of the rejection as to claims 2-14.

Moreover, Applicant respectfully traverses the rejection as to claims 2-14, because the Action fails in many instances to provide any evidence as to how Cudahy renders the additional limitations of these claims obvious. For claims 2-4, 6-10, 13, and 14, the Action simply states that the claim is rejected for at least substantially the same reason provided by the disclosure of Cudahy recited in the obviousness rejection of claim 1. As indicated above, Cudahy fails to render claim 1 obvious and therefore these rejections must fail. Moreover, the rejection as to these claims must fail because the Action fails to provide any evidence as to how the additional

limitations are rendered obvious by Cudahy much less the substantial evidence that is required in order to support a *prima facie* case of obviousness for these claims. Thus, for this additional reason, Applicant respectfully request withdrawal of the rejection as to claims 2-14.

In rejecting independent claim 15 and claims 16-28 which depend therefrom, the Action again simply states that the claims are rejected for the same reason provided in the obviousness rejection of claim 1. Accordingly, Applicant respectfully traverses this rejection and requests that it be withdrawn for at least the reasons stated above with regard to claims 1-14.

Applicant respectfully requests that references be provided to support any official notice taken in this Action or any subsequent Action.

**CONCLUSION**

Based on the above amendments and remarks, Applicant believes that the claims are in condition for allowance and such is respectfully requested. Applicant believes that no additional claims fees are necessitated by this response. However, the Commissioner is hereby authorized to charge any additional fees or credit any overpayments to our Deposit Account No. 13-0480 referencing the attorney docket number 67175120-001100.

Respectfully Submitted,

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